



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/238,972	01/27/99	MACLEOD	C D5232CIP3

HM12/1019

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EXAMINER	
WANG, A	
ART UNIT	PAPER NUMBER
1635	9

DATE MAILED: 10/19/99

Below is a communication from the EXAMINER in charge of this application

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ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

a) ☒ is extended to run _____ or continues to run 3 from the date of the final rejection

b) ☒ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 10/12/99 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing on appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: none

Claims objected to: none

Claims rejected: 1-9, 16, 217 (reasons at record)

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See Supplemental sheet

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Supplemental Sheet

Applicants request for reconsideration has been considered but found non-persuasive. Applicants allege that priority for the instant application should be granted to the filing date of 07/509,684 since applicants have incorporated the contents of 07/509,684, 07/686,322, and 08/187,634 into the instant application by referencing said applications in the first line of the application. Although it is not disputed that said applications were indeed referenced, the mere citation of said applications is not sufficient to incorporate their contents by reference. MPEP 608.01(p) clearly states that "[m]ere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference". Moreover applicants cite Section 201.11 of the MPEP to support their contention that they do deserve priority to the originally filed application. Upon review of section 201.11 of the MPEP, especially part A, it is clearly stated that "[t]he second application must be an application for a patent for an invention which is also disclosed in the first application", which in this particular case is unfounded since 08/187,634 (the first application) does not contain any reference to antisense technology thereby preventing 09/238,972 (the second application) from priority date benefit under 35 U.S.C. 120. Additionally, 09/238,972 cannot be granted 35 U.S.C. 120 priority benefit to either 07/509,684 or 07/686,322 since neither application was co-pending with 09/238,972. Therefore, as discussed above, claims 3, 16, and 17 remain rejected under 102(b) for the same reasons of record.

Claims 3 and 16 remain rejected under 112, first paragraph, written description, for the same reasons of record. Applicants allege that it would not require undue experimentation to find and use antisense oligos to CAT2 since the gene was disclosed and sequence known in the art.

Although the sequence of CAT2 was known applicants were not in possession of any particular oligo sequences which were inhibitory other than SEQ ID NO: 2. Applicants argue enablement but the rejection of record is a written description rejection which clearly states that applicants have not adequately shown that they were in possession of claimed invention.

Claims 1-9 and 16 remain rejected 112, first paragraph, scope of enablement, for the same reasons of record. Applicants allege that since the mechanisms in which genes are transcribed and translated are identical it would be logical that the inhibiting said processes would also be identical but contrary to applicants assertions, inhibition of a particular gene transcript depends on the structure of said transcript which would be unique to each gene and would therefore have to be judged on an individual basis. Moreover, applicants argue utility of the claimed invention but the rejection of record is an enablement rejection thereby rendering any grounds of argument based in utility moot.



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